

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

JAN 08 2003

TECH CENTER 1600/2900

#10  
H. J.  
2/4/03

I hereby certify that this correspondence is being deposited in the United States Postal Service as Express Mail #EV 242555908 US dated January 6, 2003 addressed to: Box Non-Fee Amendment, Commissioner for Patents, Washington, DC 20231 on January 6, 2003.

*Saul L. Jackson*

Saul L. Jackson  
Reg. No. 52,391

Applicants: Frost et al.	:	
	:	Art Unit: 1652
Application No.: 09/937,243	:	
	:	
Filing date: September 21, 2001	:	Examiner: David J. Steadman
	:	
For: Synthesis of 1,2,3,4-Tetrahydroxy- benzenes and 1,2,3-Trihydroxybenzenes using myo-inositol-1 Phosphate Synthase and Myo-Inositol 2-Dehydrogenase	:	
	:	
Attorney Docket: 6550-000038/CPB	:	

Box Non-Fee Amendment  
Commissioner for Patents  
Washington, D.C. 20231

**RESPONSE TO RESTRICTION REQUIREMENT**

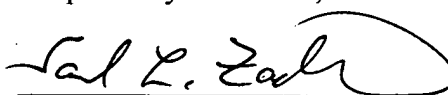
This paper is filed in response to the Office Action dated December 13, 2002. It is deemed timely filed in view of the shortened statutory period for reply set to expire January 13, 2003.

Claims 58-116 are pending in this application. In the Office Action, Restriction was deemed to be required of Group I, Claims 58-68, 79-84, 87-97, and 105-115; Group II, Claims 70-77, 85, 86, and 98-104; Group III, Claims 69 and 116; and Group IV, Claim 78. Applicants elect Group I claims for examination with traverse (37 CFR §1.143).

The restriction requirement is traversed because the inventions listed in Groups I-IV are related to a single general inventive concept under PCT Rule 13.1 and share at least one technical feature as required under PCT Rule 13.2. Reconsideration of the Restriction Requirement is requested because under PCT Rules 13.1 and 13.2, "if the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention." ("Administrative Instructions Under the PCT," Annex B, MPEP, original 8<sup>th</sup> edition, Revision 1 (August 2001) page AI-53.) In the present case, the claims of Group III (Claims 69 and 116) depend from claims of Group I. Applicant therefore submits that the Claims of Group I and Group III show no lack of unity under the Administrative Instructions. Similarly, the claim of Group IV (Claim 78) depends from claim 70 of Group II. Applicant therefore submits that the Claims of Group II and Group IV show no lack of unity under the Administrative Instructions. In addition, the bodies of art related to the claims of each Group are, in fact, interrelated and a serious burden would not result if the Restriction were not made. MPEP §803. The subject matter of Groups I-IV includes at least a microbe comprising a recombinant DNA encoding *myo*-inositol-1-phosphate synthase. Furthermore, methods for the production of 1,2,3,4-tetrahydroxybenzene cited by the Examiner are all chemical methods that do not involve the use of a microbe comprising a recombinant DNA encoding *myo*-inositol-1-phosphate synthase. The inventions listed in Groups I-IV therefore are related to a single general inventive concept under PCT Rule 13.1 and share at least one technical feature as required under PCT rule 13.2. Withdrawal of the Restriction Requirement is, therefore, requested.

It is believed that all of the claims in both Groups of claims in this application are in a condition for further examination, and such favorable action is requested.

Respectfully submitted,

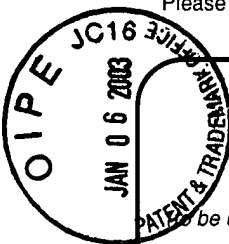


Saul L. Zackson  
Reg. No. 52,391  
Harness, Dickey & Pierce  
7700 Bonhomme, Suite 400  
St. Louis, Missouri 63105  
(314) 726-7500

01-07-03

1652

PDP/SB/21 based on PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☐

# TRANSMITTAL FORM

to be used for all correspondence after initial filing)

Application Number 09/937,243

Filing Date September 21, 2001

First Named Inventor Frost et al.

Group Art Unit 1652

Examiner Name David J. Steadman

Total Number of Pages in This Submission

3

Attorney Docket Number

6550-000038/CPB

RECEIVED

JAN 08 2003

TECH CENTER 1600/2900

## ENCLOSURES (check all that apply)

☐ Fee Transmittal Form☐ Fee Attached☒ ~~Amendment~~ Response☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/  
Incomplete Application☐ Response to Missing  
Parts under 37 CFR  
1.52 or 1.53☐ Assignment Papers  
(for an Application)☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ After Allowance Communication to  
Group☐ Appeal Communication to Board of  
Appeals and Interferences☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)  
(please identify below):Response to Restriction  
Requirement  
Return post card

Remarks

The Commissioner is hereby authorized to charge any  
additional fees that may be required under 37 CFR 1.16 or 1.17  
to Deposit Account No. 08-0750. A duplicate copy of this  
sheet is enclosed.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm  
or  
Individual name

Harness, Dickey &amp; Pierce, P.L.C.

Attorney Name  
Saul L. JacksonReg. No.  
52,391

Signature

Saul L. Jackson

Date

January 6, 2002

## CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

Typed or printed name

Mary Muir

Signature

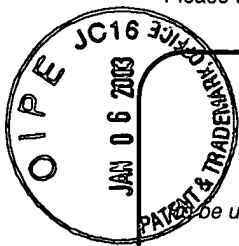
Mary Muir

Date

January 6, 2002

Express Mail No. EV 242555908 US

EV 242555908 US

Please type a plus sign (+) inside this box → ☐

# TRANSMITTAL FORM

To be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b> To be used for all correspondence after initial filing)		Application Number	09/937,243
		Filing Date	September 21, 2001
		First Named Inventor	Frost et al.
		Group Art Unit	1652
		Examiner Name	David J. Steadman
Total Number of Pages in This Submission	3	Attorney Docket Number	6550-000038/CPB

RECEIVED

JAN 08 2003

TECH CENTER 1600/2900

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <b>Response to Restriction Requirement</b> <b>Return post card</b>
Remarks The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Saul L. Zackson	Reg. No.	52,391
Signature					
Date	January 6, 2002				

## CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.			
Typed or printed name	Mary Muir		
Signature		Date	January 6, 2002

Express Mail No. EV 242555908 US

EV 242555908 US